



Paper No. 15

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JUL 19 2004

**OFFICE OF PETITIONS
ON PETITION**

In re Application of :
Davide Grassetti and Camillo Moro :
Application No. 10/044,463 :
Filed: January 10, 2002 :
Attorney Docket Number: 497872000400 :
Title of Invention: METHOD OF :
IMMUNOMODULATION USING :
THIONE-FORMING DISULFIDES :

This is a decision on the renewed petition filed June 4, 2004 under 37 CFR 1.137(a) to revive the above-identified application.

The petition to revive under 37 CFR § 1.137(a) is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR § 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely submit a response to the Notice to File Missing Parts of Nonprovisional Application mailed March 14, 2002. The notice set an extendable 2 month period for reply. No extensions of time pursuant to 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on May 15, 2002. A Notice of Abandonment was mailed on December 15, 2003. Petitions filed under 37 CFR 1.137(a) were dismissed on March 23, 2004 and May 18, 2004.

PETITION TO REVIVE UNDER 37 CFR § 1.137(a)

A grantable petition under 37 CFR § 1.137(a) must be accompanied by:

- (1) the required reply,¹
- (2) the petition fee,
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and
- (4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

¹ In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The instant petition lacks item (3).

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR §1.137(a).

The Office may revive an abandoned application if the delay in responding to the relevant outstanding office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR § 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" is applicable to ordinary human affairs, and requires no more greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business."); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2D 1130 (N.D. Ind. 1987).

In the present petition, petitioner renews arguments that petitioner is not responsible for the abandonment of the above-identified application. Petitioner contends the law firm of Morrison & Foerster had full responsibility to prepare and prosecute the application and their failure to submit the declaration and the late oath surcharge fee caused the application to become abandoned. Petitioner states when a request was made to the law firm of Morrison & Foerster that restricted services due to rising cost, Morrison & Foerster unilaterally terminated services prior to their submission of the documents to the USPTO. Petitioner contends his reliance upon the reputation of Morrison & Foerster was reasonable. Lastly, petitioner argues that health concerns made him unable to deal with patent issues.

Petitioner's arguments have been considered but they are not persuasive to establish unavoidable delay. It is noted that petitioner is ultimately responsible for the prosecution of his application. The USPTO must rely on the actions and inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions and inactions. See Link v. Wabash Railroad Co., 370 U.S. 626 (1962). Petitioner had a responsibility to monitor the law firm's performance under the contract or diligently inquire of the attorney or the USPTO into the status of the application. Petitioner was on notice on or about May 7, 2002 that Morrison and Foerster no longer intended to represent petitioner in the prosecution of the application. Yet petitioner has not provided any information as to why action was not taken in May of 2002. There was sufficient time for petitioner to submit the response to the Notice of Missing Parts with an appropriate request for extension of time. Furthermore, the USPTO sent petitioner a Notice of Acceptance of Power of Attorney mailed on February 3, 2003 indicating that all correspondence would be sent to petitioner's address. A petitioner who is treating his application as his most important business would have contacted Morrison & Foerster to insure that appropriate action had been taken on his behalf. If it was determined Morrison & Foerster had not handled the application as petitioner desired, it is then petitioner's responsibility to either timely seek other counsel or prosecute the application on his own behalf. Furthermore, petitioner is reminded that the Patent and Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative.²

An adequate showing of unavoidable delay must also include a showing from Morrison & Foerster as to why action was not taken to prevent the application from becoming abandoned

²Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

while the application was under Morrison & Foerster's control. Petitioner should send a letter (accompanied by a copy of this decision) to Morrison & Foerster by registered or certified mail, return receipt requested, indicating to Morrison & Foerster that the USPTO is requesting their assistance in determining the circumstances surrounding the abandonment of this application, and is specifically requesting Morrison & Foerster to provide a statement determining the circumstances surrounding the abandonment of this application, and is specifically requesting Morrison & Foerster to provide a statement as to: (1) why a response to the Notice of Missing Parts and any required extensions of time were not filed and (2) when Morrison & Foerster received the declaration that petitioner purportedly mailed after February 4, 2002. Such statements should be accompanied by copies of any documents (e.g. correspondence between petitioner and counsel) relevant to the outstanding Notice. In the event that Morrison & Foerster fails to provide a statement within a period (e.g., within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to Morrison & Foerster with any renewed petition under 37 CFR 1.137(a).

As to petitioner's assertion of health difficulties, a showing of unavoidable delay based upon illness/incapacitation must establish that applicant's illness was of such a nature and degree as to render petitioner unable to conduct business (e.g. respond to the Office Action) during the period between March 14, 2002 and until the filing of a grantable petition. To the extent applicant continues to believe his illness made him incapable of conducting business, applicant should submit, medical records, statements from any specialist applicant has seen from March 14, 2002 thru the present. Petitioner should also indicate whether he was capable of maintaining employment during the time period in question. Petitioner should provide information as to who took care of petitioner's day to day business. Showing of unavoidable delay based upon illness/incapacitation must establish that applicant's illness was of such a nature and degree as to render petitioner unable to conduct business (e.g. respond to the Notice of Missing Parts) during the period between March 14, 2002 and until the filing of a grantable petition. To the extent applicant continues to believe his illness made him incapable of conducting business, applicant should submit, medical records, statements from any specialist applicant has seen from March 14, 2002 thru the present.

Accordingly, the showing of record is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. 151 and 37 CFR 1.137 (a).

Alternative Venue

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR § 1.137(b) must be accompanied by the required reply, the required petition fee (\$665), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR § 1.137(b) was unintentional.³

The filing of a petition under 37 CFR § 1.137(b) cannot be intentionally delayed, and therefore, must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR § 1.137(b).

Petitioner is reminded a proper change in correspondence address has not been provided. Until such time, all correspondence will continue to be mailed to the correspondence address of record.

³It is not clear as to whether petitioner intended to file a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application. The unintentional petition fee is currently \$665. Since a fee was not submitted, the petition was treated as a renewed petition under 37 CFR 1.137(a) (unavoidable).

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By delivery service: U.S. Patent and Trademark Office
(FedEx, UPS, DHL, etc.) 220 20th Street S.
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